

Remarks

Claims 70-112 were pending in the subject application. By this Amendment, claims 70-112 have been cancelled and new claims 113-153 have been added. The undersigned avers that no new matter is introduced by this amendment. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 113-153 are currently before the Examiner for consideration. Favorable consideration of the pending claims is respectfully requested.

In the previous Amendment dated June 23, 2003, the applicants cancelled claims 39-69 and added new claims 70-112. By this Amendment, claims 70-112 have been cancelled in order to correct obvious typographical errors in the numbering of the claims and the claim dependencies. Claims 70-112 have been rewritten as new claims 113-153. With the exception of references to claims numbers, the following remarks are substantially identical to those submitted in the previous Amendment.

The applicants gratefully acknowledge the Examiner's withdrawal of the objections and the rejections under 35 U.S.C. §112, second paragraph, 35 U.S.C. §102(e), §102(b), and §103(a), based on U.S. Patent No. 5,336,615 and Accession Numbers AAQ46688 and AAR39706 of WO 93/14193A. The applicants also gratefully acknowledge the Examiner's indication that claims 41, 43, 46, and 48 would be allowable if rewritten in independent form.

Claims 39, 40, 42, 44, 45, 47, 49-52, 54, 56-58, 61, 62, 66, and 67 are rejected under 35 U.S.C. §112, first paragraph, as lacking sufficient written description. The applicants respectfully submit that the claimed invention is fully described by the subject specification. However, by this Amendment, the applicants have cancelled claims 39-69 and added new claims 113-153. Claims 113, 117, 123, 129, 137, 147, and 150 recite that the polynucleotide encodes a mutant c-Src polypeptide comprising SEQ ID NO:4. Claims 116, 121, 127, 136, and 146 recite that the polynucleotide encoding the mutant c-Src polypeptide comprises nucleotides 1 to 1593 of SEQ ID NO:3, or a full-length complement thereof. Support for claims 113-153 can be found, for example, at page 2, lines 30-33, page 3, lines 1-44, page 7, lines 6-27, page 8, lines 12-33, page 9, lines 10-11, page 10, lines 11-26, page 11, lines 1-24, page 12, lines 24-32, and page 31, lines 27-32, of the subject specification, as well as the claims as originally filed.

As acknowledged at page 4 of the Office Action, the subject specification provides sufficient written description of the mutant c-Src polynucleotide of SEQ ID NO:3 and the mutant c-Src polypeptide of SEQ ID NO:4. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

Claims 51-56 and 66-69 are rejected under 35 U.S.C. §112, first paragraph, as non-enabled by the subject specification. The applicants respectfully submit that the claimed invention is fully enabled by the subject specification. However, as indicated above, the applicants have cancelled claims 39-69, rendering this rejection moot. Claims 51-56 have been rewritten as new claims 117-122, and claims 66-69 have been rewritten as new claims 147-149. New claims 117-122 and 147-149 recite that the transgenic cells are "isolated", as recommended by the Examiner at page 10 of the Office Action. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

Claims 57-60 are rejected under 35 U.S.C. §112, second paragraph, as indefinite. The applicants respectfully submit that the claims are not indefinite. However, as indicated above, the applicants have cancelled claims 57-60, rendering this rejection moot. Claims 57-60 have been rewritten as new claims 129-136, which recite that the oligonucleotide is capable of recognizing and distinguishing a mutant c-Src gene from a wild-type c-Src gene. Thus, the metes and bounds of the claimed invention can be readily determined by one of ordinary skill in the art. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph.

Claims 57-62 have been rejected under 35 U.S.C. §102(b) as being anticipated by the 1997/1998 Stratagene catalog (page 118, 1997/1998). Claims 57-62 have also been rejected under 35 U.S.C. §103(a) as being obvious over 1997/1998 Stratagene catalog. The applicants respectfully submit that the cited reference does not teach or suggest the applicants' claimed invention. However, as indicated above, the applicants have cancelled claims 57-62, rendering this rejection moot. New claims 129-134 and 136-146 recite that the oligonucleotide is capable recognizing and distinguishing a mutant c-Src gene from a wild-type c-Src gene. Furthermore, claims 129 and 137 recite that the mutant c-Src polypeptide comprises SEQ ID NO:4. Claim 135 recites that the oligonucleotide comprises SEQ ID NO:5. It is well settled in patent law that, in order to anticipate

under 35 U.S.C. §102, a single reference must disclose within the four corners of the document each and every element and limitation contained in the rejected claims. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). The applicants respectfully submit that page 118 of the Stratagene catalog does not teach every element of the applicants' claimed invention and, therefore, does not anticipate the applicants' claimed invention. Furthermore, as a matter of law, a finding of obviousness is proper only when the prior art contains a suggestion or teaching of the claimed invention. Here, it is only the applicants' disclosure that provides such a teaching, and the applicants' disclosure cannot be used to reconstruct the prior art for a rejection under §103. This was specifically recognized by the CCPA in *In re Spinnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969):

The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is we must review the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 112 USPQ 364 (1959); *In re Sprock*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20 (1968). (Emphasis in original)

There mere fact that the purported prior art could have been modified or applied in a manner to yield applicants' invention would not have made the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a §103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art. . . ." *In re Dow Chemical Co.*, 5 USPQ 2d 1529, 1531, (Fed. Cir. 1988). In the reference cited in support of the §103 rejection, one finds neither. The cited reference does not teach or suggest the claimed oligonucleotides and diagnostic kits. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §102(b) and §103(a).

In view of the foregoing remarks and amendments to the claims, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

12

Docket No. USF-T136
Serial No. 09/444,711

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

The applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



Glenn P. Ladwig

Patent Attorney

Registration No. 46,853

Phone No.: 352-375-8100

Fax No.: 352-372-5800

Address: Saliwanchik, Lloyd & Saliwanchik
A Professional Association
2421 NW 41st Street, Suite A-1
Gainesville, FL 32606-6669

GPL/mv